AMENDMENTS TO THE DRAWINGS:

Please replace Figures 15, 16b, 18b, 20-21, 25-29, 30b, 31 and 33-34 with the attached replacement drawings.

Attachment: Replacement Drawings (14 sheets)

REMARKS

The Office Action dated June 14, 2007, has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto. Claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 are pending in this application. By this Amendment, the drawings are amended. No new matter has been added. Reconsideration of the application is respectfully requested.

The Office Action objects to the drawings because of informalities. The drawings are amended to overcome the informalities. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

The Office Action rejects claims 1-6, 8-13, 22-27, 29-34, 43-54 and 59-62 under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 112, second paragraph. The rejections are respectfully traversed.

In particular, the Office Action indicates that the Specification fails to provide details to make and use the claimed invention <u>without using a word processor or other known combination of computers and software</u> (Office Action, page 4, lines 15-17). However, Applicants respectfully submit that the Specification does <u>not</u> have to provide details on how to make and use the claimed invention <u>without</u> using a word processor. It appears that 35 U.S.C. § 112, first and second paragraphs, are being misused in this instance where the Office Action is placing on Applicants the burden of disproving the Office Action's hindsight reasoning. However, Applicants respectfully remind the Patent Office that the test, as clearly defined in the statute and the M.P.E.P. (§§ 2163.02 and 2163.04), is whether a person skilled in the art would be able to make and use the invention. The test is <u>not</u> whether the Specification should provide support as to how a

person of ordinary skill in the art would implement the invention in a specific way that is not claimed. The Specification <u>does not have to show</u> that a person of ordinary skill in the art could potentially <u>implement</u> the invention <u>without</u> using a word processor or other known combinations of computers and software in order to disprove the Patent Office's hindsight argument. A closer examination of the subject matter of the claims shows that all the claims fulfill the requirements of 35 U.S.C. § 112, first and second paragraphs.

The Office Action's argument was that word processor software is the most common method to create electronic books, and the Patent Office is demanding that Applicants disprove this statement by misusing the statute in 35 U.S.C. § 112, first and second paragraphs. As indicated above, the claims are supported in the specification and fulfill the requirements of the statute. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 112, first and second paragraphs, is respectfully requested.

The Office Action rejects claims 1-6, 8-13, 22-27, 29-34, 43-46, 49, 51-54 and 59-62 under 35 U.S.C. § 103(a) over Holm et al. (U.S. Patent No. 5,850,629) in view of Simpson ("Mastering WORDPERFECT® 5.1 & 5.2 for Windows") and Dictionary (Microsoft Press Computer Dictionary, Second Edition, 1994); and claims 47-48 and 50 under 35 U.S.C. § 103(a) over Holm in view of Simpson and Fawcett et al. (U.S. Patent No. 5,802,526). The rejections are respectfully traversed.

In particular, the current invention claims a method for providing text-to-audio conversion of an electronic book displayed on a viewer that includes <u>selecting an electronic book for viewing from a list of available electronic books stored in an operations center</u>, as recited in independent claim 1 and similarly recited in independent claims 8, 11, 22, 29, 32, 43 and 51.

Holm teaches an application-independent, text-to-speech control system which employs an easy-to-use transport from which a user can control most text-to-speech conversion functions without prior training (Abstract). Furthermore, the Office Action asserts that Holm teaches selecting an electronic book from a list of available books (Office Action, page 7, lines 1-2). However, the Office Action is mistaken because a closer examination of Holm indicates that Holm merely teaches loading an entire text, such as a book, into the local buffer (column 10, lines 28-32). Accordingly, Holm merely teaches loading or storing the entire text of a book in memory. However, loading or storing an entire book in memory does not encompass the claimed feature of selecting an electronic book for viewing from a list of available electronic books stored in an operation center, as recited in independent claim 1. Holm clearly teaches storing one book and translating that stored one book into speech. However, Holm does not teach the action of selecting an electronic book from a list of a plurality of available electronic books, as recited in the independent claims. Accordingly, Holm fails to disclose or suggest the features of all the independent claims.

Furthermore, Simpson teaches displaying text in a window and fails to teach displaying the page of the selected electronic book on a viewer because Simpson does not teach selecting an electronic book among a list of several available electronic books, and a combination of Simpson and Holm would result in Simpson displaying the book that is stored in memory in Holm. Accordingly, the combination of Simpson and Holm does not arrive at selecting an electronic book from a list of available electronic books and displaying a page of the selected electronic book, as recited in the

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independent claims. Thus, a combination of Simpson and Holm fails to arrive at the subject matter of the independent claims.

Dictionary merely provides some definitions and fails to cure deficiencies in Simpson and Holm in disclosing or rendering obvious selecting an electronic book from a list of electronic books and displaying the selected electronic book on a viewer, as recited in the independent claims.

For at least these reasons, the combination of Holm, Simpson and Dictionary fails to arrive at the subject matter of the independent claims.

Fawcett teaches an interactive voice response system used as an interface at a wide variety of support and information retrieval centers (Abstract), and fails to cure the deficiencies in Holm, Simpson and Dictionary, of failing to disclose or suggest the features of claims 47-48 and 50, including the features of independent claim 43.

For at least these reasons, independent claims 1, 8, 11, 22, 29, 32, 43 and 51, and their dependent claims, are patentable over a combination of all the applied references. Thus, withdrawal of the rejections of the claims under 35 U.S.C. § 103(a) is respectfully requested.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026880-00014**.

Respectfully submitted,

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